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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,162	02/15/2001	Robert Anthony Luciano JR.	83336.1540	4032
55136	7590	03/30/2007		
BALLY GAMING INC. 6601 S. BERMUDA ROAD LAS VEGAS, NV 89119			EXAMINER YOO, JASSON H	
			ART UNIT	PAPER NUMBER
			3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 09/788,162	Applicant(s) LUCIANO ET AL.	
	Examiner Jasson H. Yoo	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 153-171 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 153-171 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 153 and 162 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of "a new promotional award that is not redeemable for game play" is not supported by Applicant's specification.

Claims 153 and 162 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 153 and 162 recite the limitation of "a new promotional award that is not redeemable for game play, wherein the new promotional award is configured to alter game play of at least one game, enhance winning outcomes of at least one game, trigger a bonus game, or any combination thereof". However, the promotional award is considered to be redeemable for game play, if the promotional award is redeemed to alter game play, enhance winning outcomes, trigger a bonus game, or any combination thereof. Therefore the Examiner will assume the promotional award is redeemable for

Art Unit: 3714

game play, wherein the promotional award is configured to alter game play of at least one game, enhance winning outcomes of at least one game, trigger a bonus game, or any combination thereof

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 153-155, 157-165, 167-171 rejected under 35 U.S.C. 102(e) as being anticipated by Walker (US 6,227,972).

Walker discloses the following:

153, 162. A method for enhancing game play on a gaming machine, the method comprising:

providing at least one game on a gaming machine that is capable of receiving a new promotional award (prepaid card, cols. 4:61-5:9), wherein the new promotional award is configured to alter game play of at least one game, enhance winning outcomes of at least one game, trigger a bonus game, or any combination thereof, and wherein the new promotional award is given to a player to encourage game

Art Unit: 3714

play on the gaming machine (receive bonus points or greater jackpots, i.e. \$1,000.00 jackpot is enhanced to a jackpot amount of \$1,200.00, col. 6:18-49);

receiving the new promotional award from the player (player input that includes new promotional data is received in step 604 in Fig. 6A);

determining whether the new promotional award is applicable to at least one game on the gaming machine (determining if the satisfying conditions are met to access the balance, determining the awards are within the expiration period, determining if enough credits are available in the balance; step 710 in Fig. 7, cols. 3:47-65, 6:50-67:12, 8:1-9, 8:32-39, 10:5-61); and

reconfiguring, if applicable, the at least one game in response to the new promotional award (steps 720-755 in Fig. 7, cols. 6:18-49, 11:26-40).

154, 164. The method of claim 153, wherein the new promotional award includes time restriction data having a predetermined, fixed expiration date for the new promotional award (cols. 2:55-3:2, 5:10-6:35).

155, 165. The method of claim 153, wherein the new promotional award includes location restriction data that restricts use of the new promotional award to a predetermined location or a predetermined set of locations (The promotional award or prepaid card is restricted to be used at the casino in which the prepaid card was received by the player, cols. 2:15-53, 3:3-46, 5:15-20).

Art Unit: 3714

157, 167. The method of claim 153, wherein reconfiguring the at least one game further comprises providing additional pay lines to the game, adding additional winning indicia to the game, triggering a secondary game, or any combination thereof (Earn bonus credits, or additional award amount added to the jackpot, col. 6:18-49).

158, 168. The method of claim 153, wherein reconfiguring the at least one game further comprises providing a new pay table for the game in response to the new promotional award (The jackpot amount is enhanced from \$1,000.00 to \$1,200.00, col. 6:36-49).

159, 169. The method of claim 153, wherein reconfiguring the at least one game further comprises applying a multiplier to any winning outcomes of the game (jackpot amount is multiplied by a factor of 1.2, from \$1,000.00 to \$1,200.00, col. 6:36-49).

160, 170. The method of claim 153, further comprising issuing a new promotional award to the player during a gaming session (issued to a player as part of a payout on a slot machine, cols. 4:61-5:9).

161, 171. The method of claim 153, further comprising issuing a new promotional award to the player at the conclusion of a gaming session (issued to a player when the payout is awarded, cols. 4:61-5:9).

163. The method of claim 162, wherein receiving player input further comprises:
accepting player identification (col. 7:22-37); and
retrieving new promotional data that is associated with the player identification
(col. 7:38-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 156 and 166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker' 972 (US 6,227,972) in view of Walker'765 (US 6,364,765).

156, 166. Walker'972 discloses the method of or enhancing game play on a gaming machine using promotional awards as discussed above. Walker'972 teaches the promotional awards are awarded to the players (col. 4:61-5:9) and to attract new customers and increase customer loyalty (col. 1:12-29). The promotional awards are also used to stimulate business in a casino during off-peak periods (col. 2:46-48). The casino can increase the customer loyalty with promotional awards and regulate the usage of promotional awards during off-peak periods by including restrictions such as

Art Unit: 3714

an expiration time for the promotional awards, a time frame in which the players can use the promotional awards, or a minimum spending amount before the awards can be in effect (Figs. 5A-5B, col. 3:13-65). Furthermore, Walker'972 discloses slot machines that can receive player's information and determine if the player is within limits set by the restriction fields and use the promotional awards (step 616 Fig. 6A, col. 7:13-37, 7:59-8:9, 8:65-9:16). However, Walker'972 does not specifically teach the restriction of the new promotional award to a particular game, a set of related games, a family of games, or a predetermined subset of games. In an analogous art casino restrictions with awards Walker'765 discloses a method of playing a game where the casino restricts the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games. Walker'765 discloses a secondary game played to play in specific slot machines or types of slot machines (cols. 7:3-815), in order for the casino operators to effectively utilize the valuable floor space of a casino. By encouraging player to move to higher profit machines or encouraging an idle player to play any machine, casinos can achieve a higher profit per machine. Directing slot players to particular machines also benefits players by enhancing or expanding their gaming experiences (col. 3:32-43). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker'972's gaming method and incorporate a location restriction, restricting the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games, in order to utilize the floor space of a casino and encourage players to move to higher profit machines.

Response to Arguments

Applicant's arguments filed 1/2/07 have been fully considered but they are not persuasive. Applicant asserts that Walker does not teach the new promotional award is not redeemable for game play. However as discussed above, Applicant has not supported the negative limitation, and the limitation was not describe in the specification in such a way as to enable one skilled in the art to which it pertains.

Applicant argues that Walker is a prepaid card (debit/gift card) that is a substitute for the player using cash to play a gaming machine; in which the card may be purchased, given out by the casino, or issued to a player as a payout on a slot machine. However, Applicant does not claim how the player receives the promotional award. Applicant claims the promotional award is used to alter the game play. As noted above, Walker teaches the promotional award is used to alter game play (i.e. \$1,000.00 jackpot is enhanced to a jackpot amount of \$1,200.00, col. 6:18-49).

Applicant argues that Walker does not teach Applicants claimed invention claims in which the new promotional award may be configured to work on certain gaming machines. However, the claimed invention does not claim, "the new promotional award may be configured to work on certain gaming machines". As Applicant argued, Walker's promotional award is in form of credits. The gaming machine determines if the promotional award is applicable if the player has enough award credits in the balance. The gaming machine further determines if the promotional award is applicable if the predetermined condition is met (i.e. play a certain amount), and if the promotional award is within the expiration period.

Applicant further argues that Walker does not teach reconfiguring at least one game. However, Walker teaches increasing the jackpot on a game. A game is reconfigured if the payout of the game is reconfigured. Furthermore, the claim invention recites the limitation of "reconfiguring, if applicable". Thus the indefinite claim limitation does not require reconfiguration of a game.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

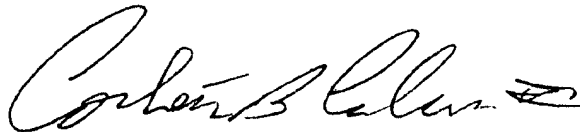
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHY

A handwritten signature in black ink, appearing to read "Corbett B. Coburn" followed by a stylized flourish.

**CORBETT B. COBURN
PRIMARY EXAMINER**